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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/910,425	07/20/2001	James V. Tietz	55579USA2B	4868
32692	7590	12/23/2004	EXAMINER	
3M INNOVATIVE PROPERTIES COMPANY PO BOX 33427 ST. PAUL, MN 55133-3427			SHAKERI, HADI	
			ART UNIT	PAPER NUMBER
			3723	

DATE MAILED: 12/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/910,425	TIETZ, JAMES V.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Hadi Shakeri	3723	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. ____.  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>080904</u> .  | 6) <input type="checkbox"/> Other: ____.                                    |

## DETAILED ACTION

### *Specification*

1. The disclosure is objected to because of the following informalities: Brief Description for each drawing should be provided, as it appears, Figs. 4 and 9 should be labeled as "Prior Art"; page 9, line 12, "figure 13" should be amended.

Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

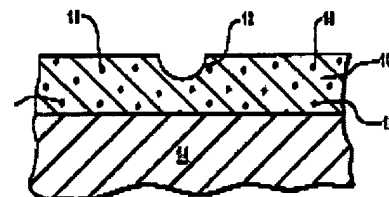
2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 3, 6-9, 11, 12, 15, 19 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Robinson et al. (US 5,733,176).

Robinson et al. discloses all the limitations of claim 1, i.e., a fixed abrasive article comprising three dimensional abrasive composites elements (18, 10) and wear indicator (16).



Regarding claims 3, 6-9, 11, 12, 15, 19 and 20, Robinson meets the limitations, e.g., wherein the abrasive article is "textured" pad, erodable, visible marker (dye) in the binder (10), coated and/or embedded on/in an abrasives surface.

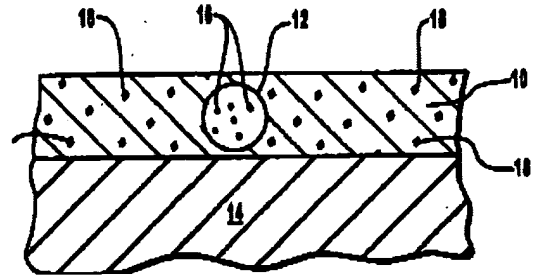
### *Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 3-9, 11, 12-16, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Admitted Prior Art (AAPA) in view of Robinson et al.

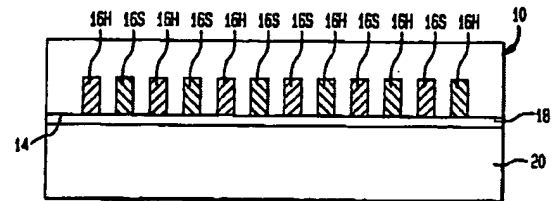
AAPA, e.g., references cited and incorporated, meets all the limitations of claim 1, except for disclosing a wear indicator. Robinson et al. teaches placing a wear indicator in the form of a chemical, physical and/or optical disposed in a void in the binder. It would have been



obvious to one of ordinary skill in the art, at the time the invention was made, to modify the invention of AAPA with the pad indicator as taught by Robison et al. to indicate the time for changing the pad.

6. Claims 1, 3-9, 11, 12-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over AAPA in view of Cheek et al.

AAPA, e.g., references cited and incorporated, meets all the limitations of claims 1 and 17, except for disclosing a wear indicator, in the form of a post (claim 17). Cheek et al. teaches placing a post like wear indicator



in the binder. It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the invention of AAPA with the pad indicator as taught by Cheek et al. to indicate the time for changing the pad.

### **Conclusion**

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

#### ***Response to Arguments***

8. Applicant's arguments filed 08/09/2004 have been fully considered but they are not persuasive.

The arguments regarding Robinson that it does not disclose a textured three-dimensional abrasive composite, rather a flat polishing pad and further not meeting the definition for the abrasive composite element, are not persuasive since as defined by the specification, abrasive composite element are abrasive particles and a binder (page 5, line 6); as for "textured" body, i.e., "having raised portions and recessed portions in which at least the raised portions contain abrasive particles and a binder" (page 6, lines 8 and 9), the "grooves" in Robinson, e.g., per Fig. 2, and col. 7, lines 15-17, meets the limitations.

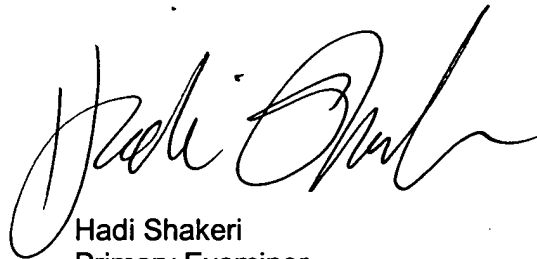
The arguments regarding AAPA that is omnibus and is not understood by the Applicant is not persuasive either, since as indicated in the office action, AAPA, e.g., references cited and incorporated meets all the limitations of the claims, except for the wear marker. Applicant admits throughout the specification that polishing pads having "textured three-dimensional abrasive composite" are old and well known in the art, e.g., page 6. These pads meet all the limitations except for a wear marker, which is taught by Robinson or Cheek as indication for changing the worn pad, in avoiding, e.g., poor polishing, damaging the workpiece, etc.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hadi Shakeri whose telephone number is (571) 272-4495. The examiner can normally be reached on Monday-Friday.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Hadi Shakeri', is positioned above the printed name and title.

Hadi Shakeri  
Primary Examiner  
Art Unit 3723  
December 20, 2004